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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,273	03/12/2004	Yoshinobu Kaneko	1419.1059C	5865
21171	7590	10/05/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			WILLIAMS, JAMILA O	
			ART UNIT	PAPER NUMBER
			3712	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/798,273

Applicant(s)

KANEKO ET AL.

Examiner

Jamila O Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,8,9 and 11-32 is/are rejected.
- 7) ☒ Claim(s) 3,6,7 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/12/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,783,423. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent are of similar subject matter but narrower in scope, thereby meeting the broader limitations of this application.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the battery containing part (see page 8 paragraph [0026] line 3) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The disclosure is objected to because of the following informalities: The language in the specification with regards to the "radiation plate" and "radiation effect" (page 4 paragraphs [0012-0013]) is objected to because of the use of colloquial and idiomatic expressions which appear to be a literal translation. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 4, 11, 15, 20 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear from the specification pages 4-5 paragraphs [0014-0017], what is encompassed by the phrase "the motor containing part being provided with a conductive piece, the motor holding plate is made of conductive material". This is unclear because it appears from the cited portion of the specification that only the "pieces" are conductive and not the "plate". It is unclear from the specification pages 4 paragraph [0012] and 10 paragraph [0035] what is encompassed by the phrases "...has a shape with a high radiation effect" and "...has a form with a high radiation effect".

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 15, 20, 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is encompassed by

the phrases "has a shape with a high radiation effect", as recited in claims 15 and 20 and "has a form with a high radiation effect", as recited in claim 25.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1,8 are rejected under 35 U.S.C. 103(a) as being unpatentable over '571 to Dicke (on ids filed 3/12/04). Dicke discloses a motor attachment plate or motor clip (77) hooking on one side to a hinge means (78, is interpreted to be a shaft type hinge connection since the specification column 4 lines 29-31 cites that in the alternative the hinge may be a molded piece instead of a "non molded" piece leading one of ordinary skill in the art to believe that 78 is some type of shaft type hinge, fig 4) attached to a base body (70) to rotate into open and closed positions, attachable to/ detachable from the base on the opposing side (hook 87). Regarding the limitations of the preamble (reciting an attachment structure of a motor of a toy), it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not

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depending for completeness upon the introductory clause. *Kropa v Robie*, 88 USPQ 478 (CCPA 1951). In addition there is not structural limitation of the "toy" which differentiates it from the device of Dicke.

11. Claims 1,2,5,8,9,12-26,30,31,32 are rejected under 35 U.S.C. 103(a) as being unpatentable over '812 to Dipnall or '013 to Fujitani or '485 to Jolley in view of '921 to Klint et al. (on ids filed 3/12/04). Dipnall, Fujitani and Jolley all disclose motor attachment plates or clips (20,3 and 42 respectively) including a member received in an engage portion on the base (fig 2, 3 and col. 4 lns. 54-56 respectively) attachable to/detachable from the base. These references do not however provide a teaching for a shaft type hinge connection. It is well known to have covers with hinge type connection as shown by Klint (see figure 3-4, the hinge 23) in the toy art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the shaft type hinge connection in of Klint with the cover of Dipnall or Fujitani for the purpose of providing easier access. This combination further provides the shaft of the motor and the shaft of the motor clip to be approximately parallel, as recited in claims 2,9. Regarding the limitations of the claims directed towards the motor holding plate comprising metal or synthetic resin, it is well known to make toy parts out of ABS plastic (see patents 5,368,516 and 5,259,808 for example) and aluminum (see patents 5,575,021, 4,161,077 and 3,878,642 for example), therefore it would have been obvious to one having ordinary skill in the art to select one of these

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materials on the basis of its suitability for the intended use (i.e. high radiation effect, especially since applicant discloses that these materials yield a high radiation effect, page 4 paragraph [0012] of the specification). Additionally, in the reference of Fujitani the element 3e inherently causes some "radiation effect".

Fujitani also discloses having a battery containing part (5a) as recited in claim 5.

12. Claims 1,5,8,27,28,29 are rejected under 35 U.S.C. 103(a) as being unpatentable over '013 to Fujitani (ids filed 3/12/04). Fujitani discloses all of the elements of the claims as recited above including that the motor attachment member 3d is formed of flexible material, but does not clearly state that the member elastically engages the base body. However, this attachment member 3d inherently has some degree of elasticity in order to engage the base body as seen in figure 3.

13. Claims 1,5,8,27,28,29 are rejected under 35 U.S.C. 103(a) as being unpatentable over '013 to Fujitani in view of '758 to Mabuchi (ids filed 3/12/04). Fujitani discloses all of the elements of the claims as recited above, but does not disclose the motor attachment structure to be elastically engaging a portion of the base body. Mabuchi discloses a holder that is elastically engaged with the base body (fig 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the holder of Mabuchi with the holder of Fujitani for the purpose of elastically holding a motor in the toy.

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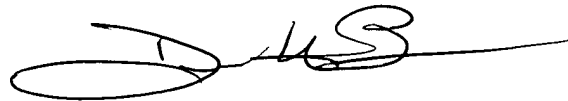
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila O Williams whose telephone number is 703-305-3312. The examiner can normally be reached on 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jw

A handwritten signature in black ink, appearing to read 'D. H. Banks', with a long horizontal line extending to the right.

DERRIS H. BANKS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700